

REMARKS

Applicant requests favorable reconsideration and withdrawal of the rejections set forth in the above-mentioned Office Action in view of the foregoing amendments and the following remarks.

Claims 20, 21, 24, 25, 28, 29, and 32-34 remain pending, of which claims 20, 24, and 28 are independent claims. Claims 20, 24, 28, and 32-34 have been amended. Support for the amendments can be found throughout the originally-filed disclosure, including for example, in Figure 19 and the corresponding description of this figure in the specification at page 33, line 13 through page 34, line 18. More specifically, Figure 19 and its corresponding description in the specification indicates, for example, that when a font size of “more than 60p,” or “6p-5p,” is specified, “Mincho typeface W7” is used without change, whereas when a font size of “5p-4p” is specified, Mincho typeface W7 is changed to “A” corresponding to “Mincho typeface W5,” while when a font size of “less than 4p” is specified, Mincho typeface W7 changed to “D” corresponding to “Gothic typeface W3.” Hence, at least this portion of the disclosure describes selecting a font in a specified typeface without changing its weight if the font size is larger than or equal to a first size, selecting the font with the thinnest weight in the specified typeface if the font size is smaller than the first size and is larger than or equal to a second size, and selecting a font in a certain typeface regardless of the specified typeface if the font size is smaller than the second size, as recited in amended claim 20. Further, page 34, lines 14-18, describe small characters being replaced so that their typefaces become intelligible and smaller characters

being replaced by most intelligible characters, as recited in claims 24 and 28. Accordingly, Applicant submits that the amendments do not include new matter.

Claims 20, 21, 24, 25, 28, 29, and 32-34 are rejected in the Office Action under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. Specifically, the Office Action asserts that the recitation of a “typeface with thin weight” in the claims is not described in the specification in such a way as to reasonably convey to one skilled in the art that Applicant, at the time the application was filed, had possession of this feature of the invention.

Applicant respectfully traverses this rejection, and submits the originally-filed disclosure provides ample support for this feature of the invention. Initially, Applicant notes that there is no in haec verba requirement for newly claimed features to be described in the originally-filed disclosure. MPEP § 2163. Instead, the originally-filed disclosure must be evaluated with respect to newly claimed features for what it would indicate to one of ordinary skill in the art through express, implicit, and inherent disclosure. Id. With this in mind, Applicant submits that the originally-filed disclosure describes the typeface weight features of the invention with sufficient clarity to satisfy the written description requirement under Section 112. For example, page 33, line 13 through page 34, line 14 of specification, describes replacing a thicker weight typeface such as Mincho typeface W3 having a character size less than 4 point with the thinner weight typeface Gothic W3, as well as other typeface weight adjustments. Further in this regard, Applicant submits that it is well-known to those in the art that the character “W” represents the weight of a font, and

that the numbers following this character indicate weights of the font, i.e., smaller numbers mean thinner weights. Still further, the originally-filed disclosure provides a written description for the amended features of the claims, as described above. Thus, Applicant submits that the originally-filed disclosure provides support for the features of the claims relating to the weight of a typeface so as to satisfy the written description requirement under Section 112.

Claims 20, 24, and 28 are rejected in the Office Action under 35 U.S.C. § 103(a) as being unpatentable over Cedar et al. (U.S. Patent No. 6,256,650) in view of Hino (U.S. Patent Application Pub. No. 2002/0036788), Yudasaka (U.S. Patent Application Pub. No. 2003/0202211) and Sakurai (U.S. Patent No. 5,562,350). Claims 21, 25, 29, and 32-34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Cedar et al., Hino, Yudasaka, Sakurai, and Hertzfeld (U.S. Patent No. 6,441,824).

Applicant respectfully traverses these rejections, and submits that the claims are patentably distinguishable from the cited references for at least the following reasons.

The Office Action acknowledges that the combination of Cedar et al., Hino, and Yudasaka fail to disclose the selection unit or selection step recited in independent claims 20, 24, and 28. In order to cure this deficiency in the references, however, the Office Action cites Sakurai as disclosing a selection unit and selection step that includes, inter alia, selecting a specified typeface with a thin weight if a font size is larger than or equal to a first size, and selecting a typeface with a thin weight in the specified font if the font size is smaller than the first size and is larger than or equal to a second size. The Office Action

concludes that it would have been obvious to one of ordinary skill in the art to modify the combination of Cedar et al., Hino, and Yudasaka with a selection unit and selection step as suggested by Sakurai.

Applicant respectfully traverses the Office Action's factual findings with respect to Sakurai. In Applicant's view, at Figure 4, and at column 3, lines 38-50, Sakurai discloses that, at step S33, if a search font character size is determined to be below a minimum character size 21, then a font type is set at step S36 that allows for a character size below the minimum character size. On the other hand, at step S34, if a search font character size is determined to be above a maximum character size 23, then a font type is set at step S37 that allows for a character size above the maximum character size. Thus, as noted at column 2, lines 59-63 of Sakurai, a specific font is designated for character sizes greater than or equal to a maximum character size.

Such disclosure does not indicate that the weight of a font in a specified typeface is changed under any condition in the apparatus and method of Sakurai. That is, while disclosure of Sakurai may indicate that a font is changed based on character sizes, there is no suggestion of a selection unit selecting a font in a specified typeface without changing its weight if the font size is larger than or equal to a first size, and selecting the font with the thinnest weight in the specified typeface if the font size is smaller than the first size and is larger than or equal to a second size, as recited in amended independent claim 20. Further, there is no disclosure in Sakurai of a selection step selecting a font so that small characters are replaced so that their typefaces become intelligible and smaller characters are

replace by most intelligible characters, as recited in amended independent claims 24 and 28.

Applicant further submits that the citation to Hertzfeld fails to cure the above-noted deficiencies of Cedar et al., Hino, Yudasaka, and Sakurai. Hertzfeld is cited in the Office Action as suggesting certain features of the claims. Nevertheless, in Applicant's view, Hertzfeld does not disclose or suggest the selection unit or selection step recited in amended independent claims 20, 24, and 28, which, as described above, are also not suggested by the other cited references.

For at least the foregoing reasons, Applicant submits that amended independent claims 20, 24, and 28 are patentably distinguishable from the references cited in the Office Action.

The other claims are allowable by virtue of their dependency, and in their own right by reciting further features of the invention. Individual consideration of the dependent claims is respectfully requested.

In view of the foregoing amendments and remarks, it is respectfully submitted that the pending claims are allowable over the references of record, and that the application is in condition for allowance. Favorable reconsideration and early passage to issue of the application are earnestly solicited.

Applicant's undersigned attorney may be reached in our Washington, D.C. office by telephone at (202) 530-1010. All correspondence should continue to be directed to our address given below.

Respectfully submitted,

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